

## **REMARKS**

The present remarks are in response to the Final Office Action dated January 30, 2006, in which the Examiner rejected claims 1, 2, 4, 6-16 and 21-23.

The Applicant respectfully submits a new set of claims and responds to the Examiner's Detailed Action and respectfully requests the Examiner to place all pending claims detailed in the application in a state of allowance.

### **A. Prior Art Rejections (35 U.S.C. §102)**

The Examiner has rejected claims 1, 2, 4, 6, and 8-16 under 35 U.S.C. §102(b) as being anticipated over the website reference Dundas (hereinafter referred to as "Dundas").

Applicant respectfully disagrees with the Examiner's rejection, however, to expedite the prosecution of this patent application, the Applicant has modified the claims. The independent claims 1, 8, and 12 have been amended to include the following elements: a ball pattern having a depth; the impression provides information about how the ball is struck; an adhesive backing that leaves little or no residue on the hitting instrument; and a tab section that facilitates removal of the training aid.

In summary, Dundas does not teach each of these new limitations, and thus Applicant has overcome the 102 anticipation rejection.

Even if the Examiner did not consider Applicant's claim amendments, Dundas does not disclose, teach or suggest an opaque and malleable material configured to receive at least one impression formed upon impact with said ball and a hitting

instrument, a strike zone and at least one ridge. Moreover, Dundas does not describe a deformable sheet thicker than the opaque and malleable material having a front face that is adhesively attached to the opaque and malleable material, with the deformable sheet additionally having a back face with an adhesive material configured to be affixed to said hitting instrument.

The Dundas reference is a website ([www.dundasifine.com](http://www.dundasifine.com)) that showcases and offers for sale a variety of adhesive products such as pipe insulation wraps, fiber wraps, insulated ducting, foil coated self adhesives, duct wraps, generally materials directed to provide pipe insulation and proper air distribution in duct systems. In fact, Dundas shows a variety of foil backed adhesive foam pipes and duct wraps used to insulate cold water pipes to prevent condensation, pipe sweating, reduce heat loss, make installations easy, and save energy.

In summary, nowhere in the Dundas website is there any description or discussion about a training aid to strike a ball having an opaque and malleable material configured to receive an impression.

The Examiner further rejected claims 1 and 21 as being anticipated by US Patent No. 2,660,436 to Grossman (hereinafter referred to as "Grossman"). Applicant disagrees.

Grossman shows a golf playing aid having a disc of colored material, a tacky adhesive on one face of the disc for attaching the disc to the striking face of a golf club, and a readily removable waxy layer on the face of said disc opposed to the said one face (see Grossman, claim 1; FIG. 3; and col. 2, lines 2-24). However, this is entirely distinct from what is recited in Applicant's amended claim 1 where the face of the training aid to strike the ball is the opaque and malleable material while the

face of Grossman's golf playing aid to strike the ball is a waxy layer. Additionally, Grossman does not teach, describe or suggest any deformable sheet as recited in Applicant's claim 1. Furthermore, none of the Grossman passages identified by the Examiner, i.e., col. 2, lines 35-40, describe the features or elements of claim 1.

**A. Prior Art Rejections (35 U.S.C. 103)**

The Examiner further rejected claims 1, 2, 4, 6-16, 21-23 as being unpatentable over Butler, U.S. Patent 5,609,530 (hereinafter referred to as "Butler") in view of Dundas.

Applicant respectfully disagrees with the Examiner's arguments, however, to expedite the prosecution of this patent application, the Applicant has amended the independent claims 1, 8, and 12 to include the following limitations: a ball pattern having a depth; the impression provides information about how the ball is struck; an adhesive backing that leaves little or no residue on the hitting instrument; and a tab section that facilitates removal of the training aid.

Specifically, the Examiner states "Butler discloses the elements of claim 1 however, it does not clearly disclose the use of an opaque material. Butler discloses any material that can leave an impression is within the scope of the invention," referring to passages col. 6, lines 19-26, 31-36, col. 6 of Butler. Thus, the Examiner concludes that it would have been obvious to have used one of several materials as disclosed in Dundas based on cost, design, and durability considerations.

However, and in spite of Applicant's claim amendments, the Applicant contends that a person with skill would not have combined Butler with Dundas to arrive at Applicant's amended claims.

Butler describes a dynamic lie determination device where the device has an impressionable medium secure to a strike face of a club head such as a golf club and an impression-making structure formed in at least a portion of the outer surface of the target object, i.e., a ball. The purpose of the device is to form or impress the alteration in the surface of the target object and position the object on a surface with the alteration being located in a prescribed orientation relative to the surface on which the object is being positioned (see Butler, col. 2, lines 38-42, lines 45-50). Thus, the angular orientation at the time of striking the ball must be impressed upon the surface of the target object which requires that the target object be a modified ball because "it is critically important that the one or more alterations, such as the grooves 46, and the ridges 54, respectively, be straight and, where there are two or more alterations, that they be parallel." (see Butler, col. 5, 33-36). In short, the ridges or marks must have a defined direction or orientation because it is precisely the angular tilt of the strike that must be determined.

Butler's emphasizes the relative angular position between the strike face and the dynamic lie of the ball. Butler requires that the ball being struck be modified. Butler teaches a masking tape with an adhesive to record the impression. These limitations would not have been combined with Dundas because the teachings are wholly inconsistent because Dundas is directed to pipe insulation wraps, and thus there would have been no motivation or suggestion to combine these references.

In spite of these arguments, Applicant has made further amendments to the claims including: a ball pattern having a depth; the impression provides information about how the ball is struck; an adhesive backing that leaves little or no residue on

the hitting instrument; and a tab section that projects in one direction and facilitates removal of the training aid.

Applicant's amended independent claims now recite that the impression includes a ball pattern having a depth wherein the impression provides information about how the ball was struck. The Applicant's amended claims are directed to receiving a ball impression and producing a depth after striking a ball. Butler simply teaches an adhesive with masking tape (See FIG. 7) that receives an impression from a ball having grooves on the flat masking tape.

Applicant's amended independent claims also include the limitation of a tab section that projects in one direction and facilitates the removal of the training aid. The tab in the amended claim is not disclosed in Butler, even though the Examiner states that Butler discloses a tab at col. 9: lines 12 – 22. Butler simply describes an information sheet on which the element 56 is placed.

Additionally, the tab claimed by Applicant projects in one direction and does not conform to the shape of the hitting instrument. Examiner's prior art training aid does not teach this feature.

Further still, Butler does not describe the removal of the training aid with little or no adhesive remaining on the training aid.

Moreover, the combination of Butler with Dundas, even if it were possible, which Applicant denies, would not have lead a person with skill to arrive at Applicant's claims. Butler's impression medium 56 includes a soft-textured major surface 58 on one side and an adhesive backing 60 on an opposite major surface which makes the impression medium 56 secured to the impact face 30 of head 22 (see Butler, col. 6, lines 23-26, 61-63, and FIGs. 7 and 8). Thus, even assuming

Butler and Dundas may be combined, and even if we assume the impression medium includes the opaque and malleable material as claimed in claim 1, neither Butler nor Dundas does not disclose any deformable sheet that is thicker than the opaque and malleable material having a front face that is adhesively attached to the opaque and malleable material and additionally has a back face with an adhesive material that is configured to be affixed to a hitting instrument and which has a tab section that projects in one direction and facilitates removal of the training aid. Neither Dundas nor Butler discloses any of these features.

The Federal Circuit has warned that “the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome where that which only the invention taught is used against its teacher.” *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004). The Office Action relies upon a variety of features of a variety of references, which could only be done when the claims of the present application are, impermissibly, used as a guide.

Examiners must show where the prior art provides a motivation to combine the references they have combined in the obviousness rejection. Not only is such a requirement found in the case law which is binding upon the office, the MPEE §2143 also sets forth a similar requirement:

To establish a prima facie case of obviousness, three based criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vacek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As pointed out above, in the present case, none of the three criteria are met. The Office Action has not identified any suggestion from the prior art to modify the references. There is no reasonable expectation of success. To the contrary, since the teachings of the prior art are generally contradictory, as pointed out above, one of ordinary skill would be disinclined to use the references, much less combine the references and would have no reasonable expectation of success. Finally, as also pointed out above, there are claim elements which are simply not found in the prior art. For at least these reasons, Applicant respectfully requests withdrawal of the finality of the rejections based upon obviousness.


Applicants submit that all of the claims are allowable over the combination of the cited references as none of the above references, alone or in combination, suggest or describe the aforementioned features recited in Applicant's claims. The limitations of claims 1, 2, 4, 6-16, 21-23 are not taught or suggested by the prior art cited, and claims 1, 2, 4, 7-9, 11-14, 16, 21-23 are now patentably distinct and in condition for allowance, which action is respectfully requested.

**C. Conclusion**

For all the foregoing reasons, allowance of all pending claims is respectfully requested.

Respectfully Submitted;

Dated: June 30, 2006

  
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